The opinion in support of the decision being entered today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DALE BURNS and THEODORE PALLES

Appeal 2006-3035
Application 09/491,919
Technology Center 2100

Decided: July 18, 2007

Before KENNETH W. HAIRSTON, HOWARD B. BLANKENSHIP, and ALLEN R. MACDONALD, *Administrative Patent Judges*.

HAIRSTON, *Administrative Patent Judge*.

ON REQUEST FOR REHEARING

Appellants have requested a rehearing of our decision dated November 30, 2006, wherein we affirmed the obviousness rejection of claims 1 to 4, 6, 7, and 10 to 13.

Appellants argue *inter alia* (Request 3) that:

> Because the prior art, *as a whole*, teaches the *interception of email at a transit node*, there is no suggestion within the prior art or the nature of the problem to be solved or within the general knowledge of a person of ordinary skill in the art to apply the "redirect" teachings of Hypponen to the *recipient node* of Council.
>
> Appellants do not dispute that it might be obvious to apply the redirect and scanning teachings of Hypponen to Council for the reasons submitted, only that there is no reason to apply those teachings *at the recipient node* of Council in order to reconstruct Appellants[']invention, absent impermissible hindsight.
>
> Indeed, as stated on Page 3 of the Reply Brief, "the presently-claimed invention requires *forwarding or re-routing* of email received at the recipient computer from the *recipient computer* to a *screening server*. . . In contrast to this, the applied prior art ascribes to the interception method of email screening as done by ISPs or firewalls (i.e., transit nodes)."
>
> And finally, the Board of Appeals appears to have disregarded Appellants' argument on Page 4 that Hypponen' disclosure of interception and redirection to a virus server at transit nodes "teaches away from having the *recipient computer* do the rerouting, as presently claimed."

We agree with Appellants' arguments. Council, as well as Hypponen, intercepts incoming email at a transit node (i.e., ISP 5 in Council and firewall 4a or mail server 4b in Hypponen) prior to receipt by the intended recipient computer.

In Council, an email from sender computer 1 is sent directly to the ISP 5 which functions as an email screening server to determine if the sender computer is on an authorized list of email senders to recipient computer 8 (Abstract; Col. 3, ll. 14 to 19). If the sender computer is on the list, then it is available for download by the intended recipient computer (col. 3, ll. 19 to 27). If the sender computer is not on the list, then the sender computer is notified of this fact by the ISP, and is charged a fee to save the email for the recipient computer (col. 3, ll. 27 to 30). Although Council is concerned with charging a fee to the sender computer for delivery of the email to the recipient computer, it is not concerned with virus screening.

In Hypponen, an email from a sender computer that may contain a virus is sent via either the firewall 4a or the mail server 4b to the virus screening server 7 (Figure 1; paragraphs 0035 and 0036). If the email does not contain a virus, the screening server 7 routes the email via the transit node 4a or 4b to the recipient computer 2a to 2d (paragraph 0037). If the email contains a virus, then the screening server 7 may either remove the virus or quarantine the email (paragraphs 0037 and 0038). Hypponen is concerned with virus screening, but is not concerned with charging a fee to deliver email to the recipient computer.

In both references, the redirecting of the email to a screening server is performed by a transit node, and not by the recipient computer as set forth in the claims on appeal. The only teaching of record to place the redirecting function at a recipient computer is Appellants' disclosed and claimed invention, and such a teaching is not available to the Examiner in a proper obviousness rejection.

Appellants' request that we reconsider our decision is hereby granted, and our decision is modified to reflect our agreement with the Appellants. Accordingly, the affirmance of the rejection of claims 1 to 4, 6, 7, and 10 to 13 is withdrawn, and the decision of the Examiner should be changed to reversed.

REHEARING
GRANTED

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